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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.    |
|---|-------------|----------------------|---------------------|---------------------|
| 10/648,070  | 08/26/2003  | Amos S. Wasser       | 48034-010000        | 3374                |
| 33717   | 7590        | 03/25/2005           | EXAMINER            |                     |
| GREENBERG TRAURIG LLP<br>2450 COLORADO AVENUE, SUITE 400E<br>SANTA MONICA, CA 90404 |             |                      |                     | D AGOSTA, STEPHEN M |
|   |             | ART UNIT             |                     | PAPER NUMBER        |
|   |             | 2683                 |                     |                     |

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                     |                 |
|------------------------------|---------------------|-----------------|
| <b>Office Action Summary</b> | Application No.     | Applicant(s)    |
|                              | 10/648,070          | WASSER, AMOS S. |
|                              | Examiner            | Art Unit        |
|                              | Stephen M. D'Agosta | 2683            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 and 35-38 is/are rejected.
- 7) Claim(s) 31-34 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 August 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement filed 12-29-03 for DE-4302820 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

2. The following documents listed in the IDS were not considered because they were not found in the application: WO-9853629, EP-0556970 and GB-2269512.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

1. The abstract is too long and should be shortened.
2. The word "means" is found many times in the abstract, please remove.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 7-13, 18-25 and 35-36** rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander WO 99/12365 in view of Kimball US 5,953,322 and Martschitsch US Patent 6,223,026 (hereafter Hyllander, Kimball and Martschitsch).

As per **claims 1, 13 and 35**, Hyllander teaches an apparatus for wireless communications comprising:

- a) Means for wirelessly communicating with a BTS via a first protocol (figure 2, #8 and #9)
- b) Means for dialing a phone number of a remote device/phone (figure 2 shows two phones, #7 and #8) **But is silent on**
- c) Means for identifying an access phone number (different from the remote device's phone number)
- d) Means for providing access number to BTS via first protocol to indicate a connection is desired with the routing system associated with said access number
- e) Means for providing the telephone number (of remote device) to the routing system in accordance with a second protocol for call to remote device

The examiner interprets Hyllander as reading on the applicant's invention based on his teachings of:

- i) allowing a mobile phone user to connect, via the Internet, to another telephone user (see figure 2 and page 3, L13-26).
- ii) Use of an Internet address (eg. "access phone number") which allows connection across the Internet (eg. routing system) via SMS and/or TCP/IP (eg. second protocol) for a call to the remote device (see figure 2 – connect to GSM system which connects to the Internet routed network). The examiner notes that the IP Address of the remote device can either be manually or automatically transmitted to the wireless network/Internet (page 4, L5-31).
- iii) See page 4, L6 to page 7, L3 which states that an Internet address may be associated with the phone number of the mobile subscriber station for a specific period of time (eg. the mobile user's phone will have both a phone number and IP address associated with it so it can connect to the BTS and IP network for data flow). This important point is taught by **Kimball** (figure 2c shows data being transmitted from the phone that contains both the cell phone identifier #138 and an IP header #140 which inherently contains a source IP address for the mobile, eg. an "access number" which is different than the telephone number. Also see C2,L35-64 and C3, L33-50.)

Further with regard to claim 13, the examiner notes that a SIM card inherently contains memory. **Martschitsch** teaches a SIM card with both a processor and memory onboard (figure 1, #20 and #29/#26).

It would have been obvious to one skilled in the art at the time of the invention to modify **Hyllander**, such that means are provided for steps c-e and the SIM card contains memory and a processor, to provide access to a cheap alternate communications system with support data being stored on the SIM card.

As per **claim 2**, **Hyllander** teaches the ability to connect to a GSM system which, as is known in the art (and also disclosed by the applicant's specification, page 3, L1-23), provides means for storing cellular network information within a SIM (eg. for (c) and (e) of claim 1 included in the SIM in the apparatus).

As per **claims 7 and 20**, **Hyllander** teaches the use of SMS to transmit support data (abstract).

As per **claims 8-9 and 21-22**, **Hyllander** teaches several ways in which the GSM network provides the telephone number to the routing system (page 12, L8 to page 18, L22). Hence one skilled in the art would provide it using virtually any of the "channels" available between the two systems (eg. via a signaling channel or data communications channel).

As per **claims 10 and 23**, **Hyllander** teaches means e) of claim 1 that provides the telephone number to the routing system after the connection has been established (page 12, L8-24).

As per **claims 11 and 18**, **Hyllander** teaches a GSM network which inherently provides mobile unit registration upon turning on the phone and/or during an attempt to dial/receive a call (eg. step f: means for registering with said base station to accept incoming telephone calls).

As per **claims 12 and 19**, **Hyllander** teaches the transmittal of a SMS data message(s) between the network elements to allow end-to-end calling via the Internet (abstract) [eg. transmitting a message to the routing system shortly after registering indicating said apparatus is registered].

As per **claims 24 and 36**, **Hyllander** teaches wireless/GSM telephone communications (which inherently uses mobile unit registration) and also teaches SMS to send support information between the mobile unit and the communications system (and vice versa) [abstract]. Hence, a mobile is registered, SMS can be used to transmit support data and the cellular system can forward calls to the appropriate mobile phone. The examiner interprets **Hyllander** as reading on the following steps:

- a) assigning a contact phone number to each of plural subscribers

- b) receiving from a particular subscriber an electronic message that has been formatted per an established protocol, said message identifying a current telephone number for the particular subscriber
- c) receiving a telephone call on the contact telephone number for the particular subscriber
- d) automatically forwarding the call to the current telephone number by dialing the current telephone number.

based on his teachings of:

i) allowing a mobile phone user to connect, via the Internet, to another telephone user (see figure 2 and page 3, L13-26).

ii) Use of an Internet address (eg. "access phone number") which allows connection across the Internet (eg. routing system) via SMS and/or TCP/IP (eg. second protocol) for a call to the remote device (see figure 2 – connect to GSM system which connects to the Internet routed network). The examiner notes that the IP Address of the remote device can either be manually or automatically transmitted to the wireless network/Internet (page 4, L5-31).

iii) See page 4, L6 to page 7, L3 which states that an Internet address may be associated with the phone number of the mobile subscriber station for a specific period of time (eg. the mobile user's phone will have both a phone number and IP address associated with it so it can connect to the BTS and IP network for data flow). This important point is taught by **Kimball** (figure 2c shows data being transmitted from the phone that contains both the cell phone identifier #138 and an IP header #140 which inherently contains a source IP address for the mobile, eg. an "access number" which is different than the telephone number. Also see C2,L35-64 and C3, L33-50.)

Further with regard to claim 13, the examiner notes that a SIM card inherently contains memory. **Martschitsch** teaches a SIM card with both a processor and memory onboard (figure 1, #20 and #29/#26).

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that means are provided for steps c-e and the SIM card contains memory and a processor, to provide access to a cheap alternate communications system with support data being stored on the SIM card.

As per **claim 25**, Hyllander teaches routing calls through the Internet instead of using long distance wireless/PSTN conveyance (abstract) which reads on the applicant's claim of routing the call to a local device.

**Claims 3, 14, 26-30 and 37-38** rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander/Kimball/Martschitsch in view of Bamburak et al. US Patent 6,418,318 (hereafter Bamburak).

As per **claims 3 and 14**, Hyllander teaches ability to connect to a GSM system which, as is known in the art (and also disclosed by the applicant's specification, page

3, L1-3), and provides means for storing "data" **but is silent on** storing network information about plural different networks within a SIM.

Bamburak teaches selecting a preferable wireless communications service provide in a multi-service provider environment (title) whereby the mobile comprises means to connect to different providers which inherently requires the mobile to store network information so that it knows how to communicate with said multi-service providers (abstract). The examiner also points out that dual-mode and multi-mode phones are known in the art.

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the phone can select a preferable service provider, to provide means for connecting to the area's optimal communications provider during roaming.

As per **claim 26**, Hyllander teaches claim 24 **but is silent on** means for causing the wireless device to download information to update said subscriber information.

Bansal teaches the reduction of wireless calling costs whereby the cellular system (eg. SCP) downloads the best MIN to the wireless device (figure 4, #404-#428, specifically #418-#428).

Bamburak teaches selecting a preferable wireless communications service provide in a multi-service provider environment (title) whereby the mobile comprises means to connect to different providers which inherently requires the mobile to store network information so that it knows how to communicate with said multi-service providers (abstract). The examiner also points out that dual-mode and multi-mode phones are known in the art.

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the wireless device can download data from a plurality of networks and update subscriber information, to provide means to the wireless device to roam and receive update information from multiple networks for reduced cost wireless calling.

As per **claims 27 and 28**, Hyllander teaches claim 26 **but is silent on** updating information includes information regarding how to transmit the electronic message of step b) via a specific one of the wireless networks.

Hyllander teaches a GSM network but does not rule out connection to other cellular networks and dual-mode and multi-mode phone are available which can switch between different systems (as is known in the art). Hence the examiner interprets Hyllander as having the foundation that would provide means for transmitting SMS messages that can contain not only information about Internet calls, but also about other cellular networks (eg. for hand-off or re-registration).

Bansal teaches the reduction of wireless calling costs whereby the cellular system (eg. SCP) downloads the best MIN to the wireless device (figure 4, #404-#428, specifically #418-#428). Bansal also teaches network profiles (C1, L39-43) and the phone can register with a new cellular system after the MIN changes (C1, L51-54). Since dual-mode and multi-mode phones are known in the art, one would expect that

the MIN data message would be modified to contain information about other cellular networks' access information as well. [Note: data can be stored onboard the mobile unit in memory or on a SIM card].

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the update information includes how to transmit the electronic message via a specific wireless network, to provide means for the mobile unit to be able to connect to a multitude of cellular and/or data communication systems (eg. TDMA, FDMA, CDMA, GSM and/or Internet, PSTN, Private WAN, etc.).

As per **claim 29**, Hyllander teaches wireless telephone connectivity to the Internet and the ability to conduct shopping/banking operations (page 1, L10-24) among other things (eg. download electronic cash).

As per **claim 30**, Hyllander teaches wireless telephone connectivity to the Internet and the ability to connect to the Internet for entertainments purposes (page 1, L10-24) among other things (eg. download an audio file/music).

As per **claim 37**, Hyllander teaches wireless communications comprising:

a) means for storing login information (phone inherently has memory and dual-mode phones are known in the art).  
c) means for automatically in response to b), logging into the telephone communications network selected in step b) so as to allow said apparatus to receive and initiate telephone calls (mobile unit registration is inherent to all cell networks)  
d) means for automatically in response to the selecting by said means b), transmitting a message via the telephone network selected in step b) to an entity that is not a part of the telephone network selected in step b) wherein the message sent in step d) identifies a phone number at which said apparatus is reachable while logged into the telephone network selected in b) and the message is sent via a pre-established protocol. [Hyllander teaches transmission of an SMS message – abstract].

**but is silent on**

a) plural networks.  
b) means for selecting one of the plural networks (dual-mode phones inherently select the optimal phone network, and hand-offs perform a similar function within one network)

Hyllander teaches a GSM network but does not rule out connection to other cellular networks and dual-mode and multi-mode phone are available which can switch between different systems (as is known in the art). Hence the examiner interprets Hyllander as having the foundation that would provide means for transmitting SMS messages that can contain not only information about Internet calls, but also about other cellular networks (eg. for hand-off or re-registration).

Bansal teaches the reduction of wireless calling costs whereby the cellular system (eg. SCP) downloads the best MIN to the wireless device (figure 4, #404-#428, specifically #418-#428). Bansal also teaches network profiles (C1, L39-43) and the phone can register with a new cellular system after the MIN changes (C1, L51-54). Since dual-mode and multi-mode phones are known in the art, one would expect that

the MIN data message would be modified to contain information about other cellular networks' access information as well. [Note: data can be stored onboard the mobile unit in memory or on a SIM card].

Bamburak teaches selecting a preferable wireless communications service provide in a multi-service provider environment (title) whereby the mobile comprises means to connect to different providers which inherently requires the mobile to store network information so that it knows how to communicate with said multi-service providers (abstract). The examiner also points out that dual-mode and multi-mode phones are known in the art.

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the wireless device can connect to a plurality of networks, so that an optimal, least cost network can be selected as the user roams.

As per **claim 38**, Hyllander teaches claim 37 **but is silent on** further comprising means for allowing the user to cause steps b-d to be repeated with a different one of the plural communications networks being selected at each repetition of step b.

Bansal teaches the reduction of wireless calling costs whereby the cellular system (eg. SCP) downloads the best MIN to the wireless device (figure 4, #404-#428, specifically #418-#428). Bansal also teaches network profiles (C1, L39-43) and the phone can register with a new cellular system after the MIN changes (C1, L51-54).

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the mobile phone can switch manually/automatically between wireless communication systems, to provide means to the user to select, at will, the system they wish to use.

**Claims 4-6 and 15-17** rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander/Kimball/Martschitsch in view of Bansal US 6,526,272 (hereafter Bansal).

As per **claims 4, 15 and 17**, Hyllander teaches means (c) of claim 1/14 **but is silent on** identifies the access telephone number based on at least one of a current telephone number for said apparatus and a current location of said apparatus (eg. for claim 15, identify location and register with one of the different mobile systems).

Bansal teaches reducing wireless calling costs (title) whereby the MIN and location of the phone are identified (figure 4, steps 404-428, specifically #412).

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the access phone number is based on location of the user, to provide the closest access point to the user which reduces costs.

As per **claim 5**, Hyllander teaches claim 1 **but is silent on** means for:

f) analyzing the telephone number

g) means for activating said means d) and e) only if the phone number satisfies a predetermined condition.

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Hyllander does teach the advantage of connecting to a remote user via the Internet instead of costly long distance lines (page 2, L3-6) but does not specifically disclose analyzing the phone number and any predetermined condition, although one skilled in the art would provide that functionality.

Bansal teaches means for analyzing where the user is (eg. which phone number is to be called versus which MIN the mobile should use) and a predetermined condition(s) (eg. least cost) [abstract].

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the phone number is analyzed and activation is based on a predetermined condition, to determine the user's location and a cheap(er) access system.

As per **claim 6**, Hyllander teaches claim 5 **but is silent on** wherein the predetermined condition includes a criterion based on amount of toll charges for placing a call to the telephone number directly via the base station.

Hyllander does teach the advantage of connecting to a remote user via the Internet instead of costly long distance lines (page 2, L3-6) but does not specifically disclose analyzing the phone number and any predetermined condition, although one skilled in the art would provide that functionality.

Bansal teaches means for analyzing for reducing calling costs/lowest costs [abstract]. One skilled in the art would be able to calculate the cost of using the cellular network versus Hyllander's use of the Internet to place the call.

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that criteria is based on amount of toll charges directly via the BTS, to provide capability of reducing wireless costs via an alternate communication system.

As per **claim 16**, Hyllander teaches claim 14 **but is silent on** means for causing the wireless device to download information to update said subscriber information.

Bansal teaches the reduction of wireless calling costs whereby the cellular system (eg. SCP) downloads the best MIN to the wireless device (figure 4, #404-#428, specifically #418-#428).

It would have been obvious to one skilled in the art at the time of the invention to modify Hyllander, such that the wireless device can download data and update subscriber information, to provide means to the wireless device to roam and receive update information for reduced cost wireless calling.

***Allowable Subject Matter***

**Claims 31-34** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For claim 31, Hyllander does not teach maintaining a database of geographic information that includes positions of at least some of the plural subscribers and providing said geographic information upon request (for use with a phone having multiple phone numbers).

For claim 32, Hyllander does not teach maintaining a subscriber database of phone numbers, connection statuses and current telephone numbers for said plural subscribers (for use with a phone having multiple phone numbers).

Claims 33 and 34 depend upon claims 32 and 33.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta  
PRIMARY EXAMINER  
3-16-05

